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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NC
09/295,856	04/21/1999	TODD R. COLLART	IACTP005	7668

22887 7590 12/10/2002

DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
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EXAMINER
RODRIGUEZ, PAUL L

ART UNIT	PAPER NUMBER
2125	

DATE MAILED: 12/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/295,856	COLLART, TODD R.	
	Examiner	Art Unit	
	Paul L Rodriguez	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/7/02, 6/10/02* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21,24,25,31,32 and 37-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21,24,25,31,32 and 37-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 27 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The amendment filed 11/7/02 has been entered and considered. Claims 21, 24, 25, 31, 32 and 37-46 are presented for examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 6/10/02 was filed after the mailing date of the non-final rejection on 5/7/02. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Examiner would like to point out that the IDS also submitted contained a PCT search report listing the documents on the 1449, however the PCT is not related to the instant application. The PCT is related to US application 09/296098 by the same inventor as the current application. If there are other applications or patents related to this case they should be disclosed by the applicant appropriately.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 46 is are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 46 recites the limitation "said means for transmitting" in claim 46 lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21, 25, 37, 38, 40, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al (U.S. Pat 6,154,773) in view of Gupta et al (U.S. Pat 6,487,538).

Roberts et al teaches (claim 21) a method for transmitting advertising (col. 4 lines 4-13) comprising, receiving tracking information based on a tracking identifier when an electronic storage medium is accessed by a computer (col. 2 lines 47-55, col. 3 lines 45-52) determining, as a function of the received tracking information, as a function of a retailer that sold the electronic storage medium (col. 4 lines 19), an appropriate advertisement to transmit to the user (col. 4 lines 3-27), transmitting the appropriate advertisement to the user (col. 4 lines 6-11), (claim 37) wherein said appropriate advertisement comprises at least one Uniform Resource Locator (col. 4 line 13, col. 4 lines 56-58, col. 4 line 66 – col. 5 line 5, figure 2 steps 44, 48 and 49A), (claim 38) a system for transmitting advertising (col. 4 lines 4-13, figures 1&2), comprising means for receiving a tracking identifier that identifies an electronic storage medium that is accessed by a computer (col. 2 lines 47-55, col. 3 lines 45-52), and means for determining, as a function of the tracking information received, as a function of a retailer that sold the electronic storage medium (col. 4 line 19), an appropriate advertisement to transmit to the computer (col. 4 lines 3-27) (claim 43) wherein said appropriate advertisement comprises at least one Uniform Resource Locator (col. 4 line 13, col. 4 lines 56-58, col. 4 line 66 – col. 5 line 5, figure 2 steps 44, 48 and

49A), (claim 44) wherein said receiving means comprises a server computer (col. 3 line 64 – col. 4 line 3, reference 40) (claim 45) further comprising a means for transmitting the appropriate advertisement to the computer (col. 4 lines 6-11) and (claim 46) wherein said means from transmitting comprises the Internet (col. 1 line 57 – col. 2 line 4).

Roberts et al fails to teach (claim 21, 38) determining as a function of a user's Internet browser experience and (claim 25, 40) writing a transaction to a database memorializing processing.

Gupta et al teaches (claim 21, 38) determining as a function of a user's Internet browser experience (col. 4 line 66 – col. 5 line 16) and (claim 25, 40) writing a transaction to a database memorializing processing (col. 5 lines 4-6).

Roberts et al and Gupta et al are analogous art because they are both related to transmitting advertisements to a users computer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the browser experience of Gupta et al in the delivery system of Roberts et al because Gupta et al teaches targeted advertising (abstract) and that it is desirable for advertisements to target specific audiences and persons that may be interested in the specific good or service being advertised (col. 1 lines 20-34).

5. Claims 24 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al (U.S. Pat 6,154,773) in view of Gupta et al (U.S. Pat 6,487,538) as applied to claims 21, 25, 37, 38, 45 and 46 above and further in view of Brindze et al (U.S. Pat 5,822,291).

Roberts et al as modified by Gupta et al teaches most all of the instant invention as applied to claims 21 and 38 above and also teaches performing table look up (col. 4 lines 3-6). Roberts et al as modified by Gupta et al fail to teach performing a table lookup to determine one or more authorized titles.

Brindze et al teaches performing a table lookup to determine one or more authorized titles (col. 9 lines 25-49) and also teaches writing a transaction to a database memorializing processing (col. 5 lines 1-7, col. 9 line 35 – col. 10 line 20, col. 12 lines 1-18).

Roberts et al as modified by Gupta et al and Brindze et al are analogous art because they both provide tracking of individual electronic storage medium usage.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize look up of authorized titles of Brindze et al in the interactive network which provides appropriate advertising of Roberts et al as modified by Gupta et al because Brindze et al teaches controlling the authorization and use of electronic media to stop piracy of content, improved marketing by retailers and tracking of individual copies of mass produced works (col. 1 line 10-50).

6. Claims 31, 32, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al (U.S. Pat 6,154,773) in view of Gupta et al (U.S. Pat 6,487,538) as applied to claims 21, 25, 37, 38, 45 and 46 above and further in view of Takahashi (U.S. Pat 5,878,020).

Roberts et al as modified by Gupta et al teaches most all of the instant invention as applied to claims 21 and 28 above and also teaches wherein the electronic storage medium has a tracking identifier, wherein a digital code is part of the tracking identifier (col. 3 lines 50-51),

and determining is a function of a digital code (col. 4 lines 3-9). Roberts et al fails to teach the electronic storage medium comprises a burst cut area and a digital code is in the burst cut area.

Takahashi teaches an optical disc electronic storage medium comprises a burst cut area (Abstract, figure 15, figure 21, col. 20 lines 32-65) and a digital code is in the burst cut area (figure 15, figure 21, col. 20 lines 32-65).

Roberts et al as modified by Gupta et al and Takahashi are analogous art because they both store content information on an optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the Burst Cut Area of Takahashi in the interactive network which provides appropriate advertising in Roberts et al as modified by Gupta et al because Takahashi teaches increased speed for file management of mass storage devices such as an optical disc (col. 1 line 63 – col. 3 line 58).

Response to Arguments

Applicant's arguments with respect to claims 21, 24, 25, 31, 32 and 37-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Greer et al (US Pub 2001/0011226 A1) – teaches a method and apparatus for targeting advertising information transmitted over the Internet that utilizes Active X software.

Collart (U.S. Pat 6,453,420) – teaches advertising based upon a tracking identifier on an electronic storage medium.

Collart (U.S. Pat 6,405,203) – teaches advertising based upon a tracking identifier on an electronic storage medium.

Cook et al (U.S. Pat 6,338,044) – teaches Internet distributed content with embedded advertising that uses internet experience to determine advertising content, also identifies a DVD player as an internet enabled appliance.

Blumenau (U.S. Pat 6,327,619) – teaches a browser that meters access to web content such as an advertising image.

Burner et al (U.S. Pat 6,282,548) – teaches a browser that sends advertisements based on stored cookies to a computer that contains a CD and DVD type reader.

LeMole et al (U.S. Pat 6,009,410) – teaches customized advertising over the World Wide Web based upon a user profile. Previously listed in prior office action.

Ozaki et al (U.S. Pat 5,991,798) – teaches a link to an electronic storage medium that incorporates Active X technology for sending information using a URL. Previously listed in prior office action.

Angles et al (U.S. Pat 5,933,811) – teaches customized electronic advertisements based upon a consumers profile and browser activity.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:30 - 4:00 M-Th and alternate F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez
Examiner
Art Unit 2125

PLR
December 4, 2002

LEO PICARD
SUPERVISORY PATENT EXAMINER
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